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NOTES/COMMENTS:

Attached is a Response to Election Requirement Mailed on February 28, 2003.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

GROUP 3600

4-1-03

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In re Application of:
Mark Cirinna et al.§
§ Group Art Unit: 3627

Serial No.: 09/578,667

§
§
§ Examiner: McAllister, S.

Filed: May 25, 2000

For: BUSINESS-TO-EMPLOYEE WEB
SERVICES§
§ Atty. Docket: COMP:0086/FLE
§ P00-3227Assistant Commissioner
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Washington, D.C. 20231

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March 28, 2003	<i>Carla Deblaw</i>
Date	Carla Deblaw

RESPONSE TO ELECTION REQUIREMENT

In the Office Action mailed on February 28, 2003, the Examiner restricted examination of claims 1-43 in the above-referenced application. Applicants respectfully traverse the restriction and ask for the continued examination of claims 1-43. However, if the Examiner maintains the current election requirement, Applicants elect to prosecute claims 9-22 and 31-43 of Group II. Reconsideration of the restriction is respectfully requested.

In the Office Action, the Examiner restricted claims 1-43 to four groups. Group I consists of claims 1-8, which the Examiner stated were "drawn to a method for providing information, goods, or services to employees, classified in class 705 subclass 8." Group II consists of claims 9-22 and 31-43, which the Examiner stated were "drawn to a system for providing information, goods or services to employees, classified in class 705,

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subclass 26." Group III consists of claims 23-27, which the Examiner stated were "drawn to a website template, classified in class 717, subclass 100." Group IV consists of claims 28-30, which the Examiner stated were "drawn to a method for an employee to get information, goods, or services, classified in class 705 subclass 8."

Applicants respectfully submit that the restriction of claims 1-43 into four groups is improper because the Examiner has not shown that a search and examination of the claims could not be made without serious burden. There are two criteria for a proper requirement for restriction between patentably distinct inventions: (a) the inventions must be independent or distinct as claimed; *and* (b) there must be a serious burden on the examiner if restriction is required (see M.P.E.P. § 803.02, § 806.04(a)-§ 806.04(i), § 808.01(a), and § 808.02). M.P.E.P. § 803. Even assuming that the claims are distinct, the Examiner still must demonstrate that examination of the claims would be a serious burden. If the search and examination of an entire application can be made without serious burden, the Examiner *must* examine it on the merits, even though it includes claims to independent or distinct inventions. See M.P.E.P. § 803. Here, the Examiner already examined all of the claims in the Office Action mailed on September 26, 2002. The Examiner has provided no evidence why further examination of the claims would be a serious burden. Therefore, the restriction should be withdrawn.

Furthermore, Applicants also respectfully traverse the grouping of claims 1-8 and 28-30 into two separate groups, Groups I and IV. The grouping of claims 1-8 and 28-30 into separate groups was improper because the Examiner has not shown that a search and examination of the claims could not be made without serious burden. Once again, even assuming that the Examiner has shown that claims 1-8 and 28-30 are distinct, M.P.E.P. § 808.02 states that:

Where the related inventions are shown to be distinct under the criteria of M.P.E.P. § 806.05(c)-§ 806.05(i), the

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examiner, in order to establish reasons for insisting upon restriction, must show by appropriate explanation one of the following:

(A) Separate classification thereof: This shows that each distinct subject has attained recognition in the art as a separate subject for inventive effort, and also a separate field of search. Patents need not be cited to show separate classification.

(B) A separate status in the art when they are classified together: Even though they are classified together, each subject can be shown to have formed a separate subject for inventive effort when an explanation indicates a recognition of separate inventive effort by inventors. Separate status in the art may be shown by citing patents which are evidence of such separate status, and also of a separate field of search.

(C) A different field of search: Where it is necessary to search for one of the distinct subjects in places where no pertinent art to the other subject exists, a different field of search is shown, even though the two are classified together. The indicated different field of search must in fact be pertinent to the type of subject matter covered by the claims. Patents need not be cited to show different fields of search.

The Examiner has not provided evidence that Groups I and IV have: (1) separate classifications; (2) separate status in the art when they are classified together; or (3) different fields of search, as required by the M.P.E.P. for the restriction. In the Office Action, the Examiner stated that: "Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes is proper." However, Groups I and IV do not have different classifications. Both Group I and Group IV are identified as belonging to the same class and subclass: class 705, subclass 8. The Examiner also stated that: "Because these inventions are distinct for the reasons given above and have acquired

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a separate status in the art as shown by their recognized divergent subject matter, restriction for examination purposes is proper." However, the Examiner provided no evidence, that the subject matter of claims 1-8 and 28-30 have a separate status in the art or an indication of a recognition of separate inventive effort by inventors. In addition, the Examiner provided no evidence of a different field of search. As the M.P.E.P. states: "Where the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among related inventions." M.P.E.P. §808.02. Thus, the restriction of claims 1-8 and 28-30 into Groups I and IV, respectively, should be withdrawn.

Conclusion

In view of the above remarks set forth above, Applicants respectfully request that the restriction requirement be withdrawn. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,



Date: March 28, 2003

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